

No. 15,893

IN THE

**United States Court of Appeals
FOR THE NINTH CIRCUIT**

CEE-BEE CHEMICAL Co., Inc., a corporation,

Appellant,

vs.

DELCO CHEMICALS, INC., a corporation,

Appellee.

APPELLEE'S BRIEF.

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Appellee.

APPELLEE'S BRIEF.

This is an appeal by Defendant below from a final judgment of the United States District Court for the Southern District of California, Central Division, in an action for Declaratory Judgment in which the District Court held invalid and void the Whitcomb *et al.* Patent No. 2,653,116, owned by said Defendant-Appellant.

JURISDICTION.

Jurisdiction to hear and determine the issues raised by the Complaint [R. 3], Answer and Counterclaim [R. 35], and Reply [R. 39], was vested in the District Court by 28 U. S. C. 1338(a), 2201, and 2202, and 35 U. S. C. 281. In the exercise of that jurisdiction, the District Court granted [R. 130-145] Plaintiff's Motion for Summary Judgment [R. 42] and entered its Final Judgment [R. 145] dismissing Defendant's counterclaim for patent

infringement and adjudicating invalid and void the Whitcomb *et al.* Patent No. 2,653,116 [R. 226] in suit and each of the claims thereof. The Final Judgment was entered December 30, 1957, and Appellant filed its Notice of Appeal [R. 154] on January 8, 1958. Jurisdiction to review the appealed judgment is vested in this court by 28 U. S. C. 1291.

STATEMENT OF THE CASE.

This is an action by Appellee-Plaintiff, the alleged infringer of Whitcomb *et al.* Patent No. 2,653,116 [R. 226], owned by Appellant-Defendant, for a judicial declaration under 28 U. S. C. 2201 and 2202 that said Patent is invalid and void and not infringed. (Plaintiff's Complaint [R. 3] set forth additionally a count for unfair competition and another count for anti-trust violation, but these two counts were dismissed on stipulation [R. 41] during the preliminary phases of the litigation.)

Defendant's Answer [R. 35], which consisted primarily of a denial of the matters alleged in the Complaint, contained a Counterclaim [R. 36] charging Appellee-Plaintiff with infringement of said Patent No. 2,653,116 [R. 226]. Appellee-Plaintiff's Reply [R. 39] to this Counterclaim set up the defenses usually urged in a patent infringement case.

This litigation thus amounts to an ordinary patent infringement action with the parties reversed; *i.e.*, in this case, the patent owner is the defendant, and the plaintiff is the party charged to infringed. The case is also somewhat out of the ordinary in that the patent owner (Appellant-Defendant) requested a jury trial [R. 38].

At a pretrial conference, the District Judge, having a reasonable familiarity with the case by reason of certain

preliminary proceedings and certain affidavits and exhibits filed by Plaintiff in connection with an earlier Motion for a Preliminary Injunction [see Ref. R. 33], indicated that a Motion for Summary Judgment would not be out of order, and might afford an opportunity to reach a final judgment in the case without spending the time, energy and money which would be required for a full trial to a jury [R. 215-220]. Plaintiff thereupon moved [R. 42] for Summary Judgment dismissing Defendant's Counter-claim for patent infringement and declaring the patent in suit to be invalid and not infringed. This Motion was granted, a Memorandum of Decision [R. 130-145] was filed and entered, and in due course a corresponding Final Judgment [R. 153] accompanied by appropriate Findings of Fact and Conclusions of Law [R. 145] was made and entered in the case; Defendant appealed [R. 154].

QUESTIONS PRESENTED.

Appellant's Points on Appeal [R. 160] set out thirty-eight alleged errors, and the Specification of Errors in its Brief (Br. p. 2) recites some thirty-two alleged errors. The absurdity is apparent and suggests strongly that Appellant does not have a single sound ground for its appeal and is attempting to make up in quantity what it lacks in quality.

Appellant's thirty-two errors seem to be alleged *in vacuo*,—Appellant states (Br. p. 6) that there is only one question on this Appeal—" . . . is there any material issue of fact involved in this case?"

Notwithstanding Appellant's contention, Appellee submits that the obvious invalidity of the patent in suit is the first and most important matter to be considered on this appeal. When it is shown that the Court below cor-

rectly decided this substantive question, it answers any question Appellant could raise on the procedural matter of entering a final judgment of invalidity on a Motion for Summary Judgment.

This Appeal thus presents two questions: a first and substantive question of whether the District Court was correct in holding the patent in suit invalid; and a second and procedural question of whether there exists a genuine issue of material fact of such kind and character as to preclude an affirmative answer to the first question.

SUMMARY STATEMENT OF FACTS.

Appellant-Defendant Cee-Bee Chemical Co., Inc., is a California corporation [R. 4], and Appellee-Plaintiff Delco Chemicals, Inc., is a Delaware corporation [R. 3]; both parties have principal places of business in the County of Los Angeles, State of California. Appellant is the owner [R. 37] of Whitcomb *et al.* Patent No. 2,653,116 [R. 226] which was issued on September 23, 1953.

A bona fide dispute exists between the parties as to the validity of the patent in suit [R. 4] and Appellee represents to the Court that there is no genuine issue as to any material fact necessary to the consideration and determination of the question of the validity of said patent.

The patent in suit [R. 226] relates to the cleaning of tanks, its stated object being to remove coatings of sealant material from airplane fuel tanks by the claimed method or procedure of spraying a suitable solvent against the upper parts of the tank walls, allowing the sprayed solvent and any loosened sealant particles to drain out of the tank by gravity, screening the drained solvent to separate from it any sealant particles, and then recirculating the screened solvent through the sprays, after which a water

rinse is applied to the tank as is customary in cleaning operations.

Appellant has charged [R. 37] that Appellee has infringed the patent in suit by practicing the method thereof, and by making, selling and using apparatus adapted for, intended for, and actually used for the purpose of practicing such method. Appellant so notified Appellee [R. 38], a controversy ensued [R. 4], and Appellee brought this action [R. 3] for declaratory relief seeking a declaration of its right to continue by reason of the invalidity of the patent in suit.

The patent in suit [R. 226] issued September 22, 1953, on application filed March 16, 1949, by Keith R. Whitcomb and Eugene E. Finch as joint inventors, the application and the patent being assigned [see Ref. R. 227] by the inventors to appellant Cee-Bee Chemical Co., Inc. During its pendency in the Patent Office, the application was rejected four times and was five times amended before it was finally allowed and issued as a patent [see Ex. B, a physical exhibit, referred to at R. 156(29), 167(1), and R. 44].

In allowing the Whitcomb *et al.* application and issuing the patent in suit, the Patent Office cited [R. 229] and considered only the following references:

Butterworth	<i>Re</i> 19,374	[R. 231]
Foster	1,141,243	[R. 236]
Gray	1,628,141	[R. 245]
Houpt	1,892,950	[R. 249]
McFadden	2,092,321	[R. 253]
Paulson <i>et al.</i>	2,123,434	[R. 256]
Jaffa	2,442,272	[R. 260]
Brady	2,458,333	[R. 265]

In so allowing the Whitcomb application and issuing the patent in suit, the Patent Office did not cite and did not consider certain other prior patents [R. 45] which the District Court held [R. 149] to be "the most pertinent prior art":

Butterworth	2,018,757	[R. 285]
Butterworth	2,045,752	[R. 281]
Land	1,666,015	[R. 292]
Jensen	1,730,658	[R. 288]
Olsson	2,065,462	[R. 278]
Robinson	1,701,824	[R. 298]
Court	2,245,554	[R. 272]

Since Appellee, in order to continue in its business without interference from Appellant, found it necessary to secure a judicial declaration that Appellant's patent was invalid, Appellee brought [R. 3] this action for Declaratory Relief, seeking a judicial declaration of invalidity of the patent in suit.

Since the question of validity in this case is a matter of law, the patent in suit and the prior art speaking for themselves, and no genuine issues of material fact being involved, Appellee sought to expedite matters and avoid a useless trial, by bringing a Motion for Summary Judgment [R. 42]. The lower court, after full consideration of all of the evidence submitted and arguments of counsel, granted [R. 130-145] Appellee's Motion for Summary Judgment [R. 42], and entered an appropriate Final Judgment [R. 145] in accordance therewith.

SUMMARY OF ARGUMENT.

I.

WHITCOMB PATENT IN SUIT IS INVALID FOR CLAIMING OBVIOUS METHOD, BECAUSE ANTICIPATED BY PRIOR ART, AND BECAUSE LACKING INVENTION OVER THE PRIOR ART.

A patent that claims a method which is no more than the obvious method of securing the desired result, or which was already clearly described in prior patents issued more than a year before the filing of the application, or which fails to define invention over the prior art, is clearly invalid.

A. Patent in Suit Discloses and Claims a Method Which Is Obvious and Anticipated by Analogous Prior Patents.

(1) **Whitcomb Patent in Suit Describes and Claims a Simple and Obvious Process Which Is Obviously Old and Unpatentable.**

The patent in suit claims a method which consists in substance in spraying a solvent solution against the tank walls, draining the sprayed solvent out of the tank by gravity, screening the drained solvent to separate from it any coating particles removed thereby, and recirculating the screened solvent back to the sprays. Some of the claims specify additionally a final water rinsing step, with or without an emulsifying agent. Such a method has, of course, been used for many years for just such a purpose.

(2) **Examiner Allowed Whitcomb Application Because He Did Not Have the Most Pertinent Prior Art Before Him.**

A comparison of the prior art relied upon by Appellee with that cited by the Examiner shows that the Examiner did not consider the most pertinent prior art. The readily

observable differences clearly suggest that had the Examiner considered this more pertinent prior art, he would never have issued the Whitcomb patent.

(3) Every Element of Every Claim Is Found in Analogous Prior Patents Not Cited by the Examiner.

A side by side comparison of the patent in suit with Butterworth 2,018,757 establishes that the patent in suit is anticipated (or substantially so) by the Butterworth patent. Additional disclosure of many of the claimed features of the patent in suit is to be found in the prior patents to Land 1,666,015, Olsson 2,165,462 and Foster 1,141,243.

B. Being Anticipated by the Prior Art, the Whitcomb Patent in Suit Is Necessarily Void for Want of Invention.

Because the Court below found the patent in suit invalid for anticipation or *other* want of invention, Appellant would have this Court of Appeals believe that there is a weakness in the position taken by the Court below as regards anticipation. The fact is that the Court below held the patent in suit invalid and void for want of invention over the prior art [R. 153, 4th Conclusion of Law]. The lesser is included within the greater; anticipation is but one type of want of invention.

C. Invalidity for Want of Invention Is Obvious on the Face of the Patent in Suit When Viewed in the Light of the Prior Art.

The patent in suit is obviously invalid for claiming a method which is nothing more than the obvious method of accomplishing the desired result, for claiming only that which is clearly taught in the prior art, and because the method claimed is no more than a mere aggregation of steps long known and employed in the fuel tank cleaning art.

II.

INVALIDITY OF THE PATENT IN SUIT MAY BE DETERMINED ON MOTION FOR SUMMARY JUDGMENT BECAUSE PATENT IN SUIT AND THE PRIOR ART IN EVIDENCE ARE SIMPLE AND REQUIRE NO EXPLANATION AND THERE ARE NO QUESTIONS CONCERNING THEIR ADMISSION INTO EVIDENCE—VALIDITY PRESENTS A PURE QUESTION OF LAW.

Rule 56 of the Federal Rules of Civil Procedure provides the mechanism for summarily entering judgment on motion where the controlling facts are uncontested and the decision of the case is reduced to a pure question of law.

A. Admissibility of Evidence Not Questioned—All Was Properly Before Court Below.

The trial court's judgment of invalidity of the patent in suit was based solely upon documentary evidence: the patent in suit, the Patent Office file wrapper and contents, the prior patents cited by the Patent Office, and certain prior patents which were not cited nor considered by the Patent Office. The admissibility of this evidence is unchallenged.

B. The Evidence Upon Which the Decision in This Case Is Predicated Is Easily Understood—Extrinsic Evidence Is Not Required to Explain or Evaluate the Prior Art and Its Applicability to the Subject Matter of the Patent in Suit.

The controlling facts in this case are established by unchallenged documentary evidence; the documents are in the English language, they are not technical in nature or subject matter, and they relate to an extremely simple and well known process.

C. Absurd Contentions Concerning Inferences to Be Drawn From the Evidence Do Not Create Issues of Fact Which Are Either Genuine or Material.

The evidence in this case is unchallenged and uncontested and establishes the facts upon which the Court's decision is and must be based. The inferences or conclusions which could or should be drawn from these facts, particularly when considered in the light of the applicable law, are the judicial function; one does not raise a genuine issue of material fact by taking the opposite view as regards such inferences and conclusions—this is a matter for argument.

D. There Is No Issue of Fact, Genuine or Otherwise as to the Contents of the Patent in Suit, the Contents of the File Wrapper Record, or the Contents of the Various Prior Art Patents.

The documentary evidence is self-contained and speaks for itself; there can be no question as to the contents of such documents, and the admissibility of such evidence has never been challenged.

E. No Weight or Consideration Should Be Given to Appellant's Arguments on Matters Not Material to the Questions Raised by This Appeal.

This Court of Appeals can and should cut through all of the superficialities and go directly to the heart of the matter by making a simple, side by side comparison of the patent in suit with the prior art patents. When this is done, no amount of extraneous argument can conceal the obvious invalidity of the patent in suit.

F. Where the Entire Case Is Disposed of by a Decision on One Ground Which Is by Its Nature Dispositive of the Case, Factual Issues Involved in Other Grounds Are Not Material.

Having decided a pure question of law on uncontested facts which disposes of the litigation, the Court below was not required to go into any of the other questions which were, or might have been, raised in connection with other grounds or theories upon which a decision could be based. The situation here is not to be confused with the case where the trial court is required to decide the question of validity even where it finds non-infringement—this is required in order to protect the public against the threat of litigation based on an invalid patent. Here the patent has been held invalid.

G. Opinion Evidence by Expert Witness Which Is Not Needed to Explain the Patent or the Prior Art Must Be Taken for What It Is—Argument of Counsel.

The evidence in this case is simple and readily understood and expert testimony is not required. Under such conditions, testimony of an expert witness is no more than the familiar and deplorable practice of arguing the case from the witness stand; in this case, the sin is aggravated because it is done by way of an affidavit. Such arguments cannot create an issue of fact any more than any other argument presented by counsel.

III.

THE PATENT IN SUIT IS INVALID AND THE
JUDGMENT SO HOLDING SHOULD BE
AFFIRMED.

The patent in suit is obviously invalid. The court below held correctly that there was no genuine issue as to any material fact necessary to the consideration and determination of the invalidity of the patent in suit. Where, as here, it appears from the state of the art as shown to exist by the prior patents, and upon a comparison of the older processes with the method described in the patent in suit, that the patent claims are not novel, or that the claimed invention is anticipated by the prior art, it is the duty of the Court to grant summary judgment on the issue of validity. This duty being properly discharged and embodied in the Final Judgment in this cause, it is the duty of this Court of Appeals to affirm that judgment.

ARGUMENT.

I.

WHITCOMB PATENT IN SUIT IS INVALID FOR CLAIMING OBVIOUS METHOD, BECAUSE ANTICIPATED BY PRIOR ART, AND BECAUSE LACKING INVENTION OVER PRIOR ART.

A patent that claims a method which is no more than the obvious method of securing the desired result is invalid (35 U. S. C. 103; *Dow Chemical Co. v. Halliburton Oil Well Cementing Co.*, 324 U. S. 320).

A patent which is anticipated by the prior art is invalid—claims which define nothing more than what was already clearly described in prior patents issued more than a year before the filing of the application are invalid for anticipation (33 U. S. C. 102; *Mattler v. Peabody Engineering Corp.*, 77 F. 2d 56; *Muench-Kreuzer Candle Co., Inc. v. Wilson*, 246 F. 2d 624).

Patent claims which fail to define invention over the prior art are invalid for want of invention—unless the claims define differences such that the subject matter as a whole would not have been obvious to one skilled in the art at the time the invention was made, the claims are invalid for want of invention (35 U. S. C. 103; *Stauffer v. Slenderella Systems of California, Inc.*, 115 U. S. P. Q. 347).

Application of the above stated principles to the undisputed facts of the case at bar leads to a single conclusion: the patent in suit and each and every claim thereof is invalid and void.

A. Patent in Suit Discloses and Claims a Method Which Is Obvious and Anticipated by Analogous Prior Patents.

While it is believed perfectly obvious from a mere inspection of the patent in suit [R. 226] and a comparison thereof with the prior art relied upon by Appellees [R. 272-303] on their Motion for Summary Judgment, that the patent in suit is invalid, Appellee, in order that there be no misunderstanding about its position in this matter, devotes the next three sub-topics to such a comparison.

(1) Whitcomb Patent in Suit Describes and Claims a Simple and Obvious Process Which Is Obviously Old and Unpatentable.

The Whitcomb *et al.* patent in suit relates to a method of cleaning tanks, its stated object being to clean or remove from aircraft fuel tanks the coatings of sealing materials which are applied to the tank joints to prevent leakage.

The method described by the patent [R. 226] consists in spraying a solvent solution against the tank walls (no particular solvent being specified), draining the sprayed solvent out of the tank by gravity (along with any coating particles which it removes), screening the drained solvent to separate from it any coating particles, and then recirculating the screened solvent to the sprays. The patent also mentions that after the solvent cleaning is completed, it may be desirable to spray the tank with a soapy solution (the patent referring to this as a "water-rinsable, emulsifying spray"), and then to rinse the tank with water.

It must be apparent at this point that the Whitcomb method is not startlingly new and does not produce any really unexpected results. The claims, however, are unexpectedly broad and are clearly an attempt to cover per-

fectly obvious ways of cleaning tanks, as may be seen from the following side-by-side comparison of Claim 5 of the patent in suit with one obvious way of accomplishing the same result.

Claim 5.

5. The method of removing the sealant from within an aircraft integral fuel-tank, which comprises

impinging a spray of solvent, against the sealant to remove same,

washing free sealant from the tank by free solvent,

screening out sealant from the solvent,

recirculating the latter as a spray against remaining sealant,

and, when the sealant is substantially removed, applying rinse water to remove solvent and loosened sealant remaining in the tank.

A “Hand” Process.

To “hand” clean a tank having a bottom drain, we place a milk bucket with a screened top below the drain, then:

using a “Flit” gun, we spray solvent against the inner upper walls of the tank,

we continue spraying to cause solvent to run down the walls and out the bottom drain,

solvent passes through the screen and into the bucket, thus “screening out” any pieces of coating that may have been dislodged,

when our “Flit” gun is empty, we refill it from the bucket and go on with our spraying,

then, at the stated time, we turn the garden hose into the tank to rinse down the cleaned walls and flush everything out the drain.

Claim 1 is similar to Claim 5 but additionally specifies that the tank should be sealed while the method is being carried out and specifies that after the solvent cleaning is completed and before the water rinse is applied, the tank should be sprayed with a soapy solution.

Claim 2 is the same as Claim 1 except that it does not specify sealing the tank while the method is carried out.

Claim 3 is in essence the same as Claim 2 except it specifies preferred pressures for spraying the solvent and water rinse, and states that the temperature of the solvent should be fram 60° F. to 120° F. However, the patent specification does not teach that there is anything critical or significant in those particular pressures or temperatures.

Claim 4 is substantially like Claim 5 except that it specifies that the tank being cleaned has bulkheads against which the solvent is sprayed.

Claim 6 is in essence like Claim 5 except that it states that the water rinse is applied at a pressure higher than the pressure of the solvent spray.

Claim 7 is like Claim 6 except that it specifies that the water rinse pressure is 300 pounds per square inch.

Claim 8 is substantially like Claim 5 except that it omits the final water rinse step of Claim 5.

There is nothing new or startling in any of these features, and none of them produces any more than the obvious and expected result. The patent is invalid on its face.

(2) Examiner Allowed Whitcomb Application Because He
Did Not Have the Most Pertinent Prior Art Before Him.

As originally filed, the application for the patent in suit sought to patent a method as well as an apparatus for cleaning tanks. The first Patent Office Action, however, required division, and the applicants cancelled the apparatus claims and retained the claims to the alleged method. The Patent Office considered and treated the alleged invention to be in the general art of tank cleaning and rejected the original claims [see Ex. B] on the Butterworth Reissue patent No. Re. 19,374 [R. 231] and the Foster patent No. 1,141,243 [R. 236].

As was indicated by the Examiner's citations, and as will be pointed out more fully hereinafter by reference to other and more pertinent prior art, tank cleaning by continuously spraying solvents onto tank walls is a very old art. It has been extensively used in the cleaning of railroad tank cars, ship tanks, large drums and automobile radiators. Such new developments as there have been during the past twenty to thirty years have been by way of improvements in the apparatus used for such cleaning methods. Different cleaning problems require different solvents, and in some cases, require new apparatus adapted particularly to the structure to be cleaned, but the method utilized is the same in practically all cases. This was recognized by the Examiner when he cited the Butterworth and Foster patents.

The Butterworth patent Re. 19,374 [R. 231], the principal prior art relied upon by the Patent Office, shows a tank cleaning system in which solvent solution is pumped from the bottom of the tank being cleaned to sprays located in the upper part of the tank, the sprayed solvent, as well as any particles of coating which it removes, draining by

gravity down the side walls of the tank to the tank bottom from which the solution is picked up by the pump and recirculated after being passed through a settling tank. The Foster patent No. 1,141,243 [R. 236] shows that it was old to use soapy solutions and water rinses for cleaning all kinds of surfaces.

When confronted with the above-mentioned rejection of the original claims on Butterworth and Foster, the applicants for the patent in suit then cancelled the original claims, and inserted claims calling for the sprayed solvent solution to be drained by gravity from the tank and screened before being recirculated—they argued that their method differed from Butterworth Re. 19,374, and Foster 1,141,243 in that the pump of the Butterworth patent would become clogged if the solvent were recirculated from the tank bottom without being screened. Affidavits were submitted stressing the alleged importance of draining the solvent from the tank and screening it before recirculating it and stressing the alleged commercial success of the method. After two personal interviews between applicants' attorney and the Patent Office Examiner, the Examiner was persuaded by that argument to allow the claims of the patent [see Ex. B].

The Examiner's real reasons for allowing the Whitcomb claims must remain a matter of speculation and conjecture. This much, however, is obvious—the principal weakness in the Examiner's position was his lack of a prior art patent teaching the step of screening the solvent before it is pumped back to the sprays and teaching the idea of draining the sprayed solvent from the tank by gravity rather than pumping it out.

There is little room for doubt that if the Examiner had had before him the references upon which Appellee

presently relies, he would have found these steps to be old and well known in the prior art long before the alleged invention by Whitcomb and would have steadfastly refused to allow Whitcomb's claims.

(3) Every Element of Every Claim Is Found in Analogous Prior Patents Not Cited by the Examiner.

If the Patent Office Examiner had made a thorough search of the prior art as he should have done, he would have found and cited prior patents which completely anticipate the method claimed by the patent in suit—even to the draining of the sprayed solvent from the tank by gravity and screening it before recirculating it. Such anticipatory prior patents which the Examiner failed to cite and consider were relied upon by Appellee in its Motion for Summary Judgment and constituted the basis for the Summary Judgment entered by the Trial Court in this case. These patents are enumerated and identified in *Exhibit D* [R. 271-303]. A brief comment concerning the most pertinent of each of these follows:

Butterworth 2,018,757 [R. 285] in Figure 3 discloses forcing a solvent solution by a pump 29 through line 26 to sprays 30 in the tank 31 being cleaned. The solvent is sprayed onto the walls of the tank and, along with any removed coating, drains by gravity to the bottom of the tank and drains by gravity out through the outlet 33 and drains by gravity into the catch basin 35. This solvent passes through screen 38 and line 36 to the supply tank 24 from which it is recirculated by the pump 29. This patent refers to the screen 38 as a "weir," the purpose of the weir being stated in the patent as "to prevent the passage of scale or other solid material into line 26." [R. 286, right col., line 32.]

Appellant seeks to draw a vitalizing distinction between "weir" and "screen," stating that a weir is in the nature of a dam and material flows over the top of a weir and not through it. This is not the way it appears in Butterworth's Figure 2 and is contrary to the Butterworth specification.

The purpose of the weir, screen, settling basin, trap or whatever one chooses to call the instrumentality in question, is to hold back any scale or other solid material that might otherwise be drawn into the pump. If it is of any importance at all, the method step in question is that of separating out the solid material from the liquid. This is clearly taught by Butterworth 2,018,757. See also, Butterworth 2,045,752 [R. 281], page 2 [R. 283], lines 17 *et seq.* Also note the screen shown in the drawings of Jenson 1,730,658 [R. 288]. Note also the screen 31 of Court 2,245,554 [R. 272], the screen 24a of Robinson 1,701,824 [R. 298]—and note particularly that no screening means of any kind whatsoever is specified by any of Claims 1, 2, or 3 of the patent in suit.

Land 1,666,015 [R. 292] teaches the recirculation of solvent in a closed system with the tank sealed, and teaches the use of a final water rinse.

Olsson 2,065,462 [R. 278] teaches the spraying of a cleaning solvent against the bulkheads of a tank (see Claim 4 of the patent in suit), the spray draining down the bulkheads by gravity.

As before stated, the Foster patent 1,141,243 [R. 236] cited by the Examiner, shows that it is old to use soapy solutions and water rinses in connection with the cleaning of all kinds of surfaces. Appellant argues that the claims do not call for the use of a soapy solution. This is a

mere quibble on words. Foster, in teaching the use of a soapy solution, necessarily teaches the use of a water-rinsable emulsifying solution (see Claim 1 of the Whitcomb patent in suit). Obviously, a substance claimed in generic terms (Water-rinsable emulsifying solution) is anticipated by the disclosure of a specie of such material (soapy solution).

From the foregoing it is apparent that the above discussed prior art, all of which (with the exception of the Foster patent showing that it is old to use soap to clean things) was not cited or considered by the Patent Office, anticipates everything that the patentees of the patent in suit urged as being novel in order to obtain allowance of the patent claims. The Court below reached the only tenable conclusion when it found the patent in suit to be invalid because anticipated by the prior art [R. 140].

B. Being Anticipated by the Prior Art, the Whitcomb Patent in Suit Is Necessarily Void for Want of Invention.

The term "anticipation" has two meanings as applied to inventions and patentability: the first and most common meaning is that anticipation of a claim is found when the claim does not set forth anything that is not found in the prior art; the second meaning is a strict technical usage which finds anticipation when every element and feature of the claim is found in a single prior art reference but not when reliance must be had on a second reference for one or more of the claimed elements or features. In this latter case, the claim is invalid for "want of invention" if the subject matter as a whole would have been obvious to one skilled in the art at the time the invention was made (35 U. S. C. 103; *Stauffer v. Slenderella Systems of California, Inc.*, 115 U. S. P. Q. 347).

The Trial Court, thinking first in terms of the common and ordinary meaning of the word "anticipation," held the patent in suit invalid because anticipated by the prior art [R. 140]. Then, recognizing that one might base an argument upon the difference between the technical and ordinary meanings of the term, the Trial Court went on to say "Even if it be said that there appears no 'strict anticipation' of the patent in suit, and that the method involves some novelty, it nonetheless lacks invention." [R. 140.]

Appellant seeks to make capital of the quoted statement by urging to this Court of Appeals that the Trial Court was aware of an inherent weakness in its holding of anticipation. Unfortunately, such an argument only imposes upon Appellee the burden of answering it and imposes upon the Court of Appeals the double burden of considering both arguments.

The fact is that a patent invalid for want of invention is just as invalid as a patent which is anticipated. What difference does it make whether all of elements and features of the claim are found in a single prior patent or in a group of prior patents, if (as stated in 35 U. S. C. 103) the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains? As Judge Fee stated for this Court of Appeals in *Stauffer v. Slenderella Systems of California, Inc.*, 115 U. S. P. Q. 347:

"the advances in the prior art may be such that although there is no strict anticipation . . . a trained mechanic would if presented with the problem solve it without difficulty."

See also *Bergman v. Aluminum Lock Shingle Corp. of America*, 116 U. S. P. Q. 32, decided by this Court in December 1957.

C. Invalidity for Want of Invention Is Obvious on the Face of the Patent in Suit When Viewed in the Light of the Prior Art.

Appellant argues that the prior art relied upon by the Court below to support its judgment of invalidity is not analogous. Appellant's attempts to generate a distinction where none exists by calling a method of cleaning tanks a method of rebuilding tanks is so patently a clutching at straws as to require no answer. We would not presume to state it any more clearly than did the Court below:

“Clearly, no fact finder could reasonably conclude that patentable novelty subsists in the discovery that an old method used in cleaning railroad tank cars, ship tanks, drums and radiators can be adapted to the cleaning of airplane fuel tanks.” [R. 142.]

Appellant also seeks to avoid the Trial Court’s holding of aggregation by asserting to this Court that here the whole exceeds the sum of the parts. It was obvious to the Court below, as it must be to this Court of Appeals, that the concert of known steps produces no more than what is produced by the individual steps. Here again we quote the opinion of the Court below:

“The most that can be said of the patent in suit is that the method claimed to constitute invention is but a mere aggregation of steps long known and employed in the fuel tank cleaning art.” [R. 142.]

II.

INVALIDITY OF THE PATENT IN SUIT MAY BE DETERMINED ON MOTION FOR SUMMARY JUDGMENT BECAUSE PATENT IN SUIT AND THE PRIOR ART IN EVIDENCE ARE SIMPLE AND REQUIRE NO EXPLANATION AND THERE ARE NO QUESTIONS CONCERNING THEIR ADMISSION INTO EVIDENCE—VALIDITY PRESENTS A PURE QUESTION OF LAW.

It is an elementary and fundamental proposition that in the peculiar case where the controlling facts are uncontested and the decision of the case is reduced to a pure question of law, judgment may be entered summarily upon proper motion (F. R. C. P. 56(c)).

A. Admissibility of Evidence Not Questioned—All Was Properly Before Court Below.

The evidence before the Court below was the patent in suit No. 2,653,116 [R. 226], a certified copy of the file wrapper and contents of the patent in suit [Ex. B], the prior patents cited by the Patent Office against the application for the patent in suit [R. 230-270], the heretofore listed prior patents which were not cited nor considered by the Patent Office [R. 271-303], and certain other documentary evidence (not here important because it did not furnish a basis for the decision of the Lower Court).

All of this evidence was introduced in connection with Appellee's Motion for Summary Judgment by means of an affidavit of Appellee's counsel, Walter P. Huntley, which affidavit is completely free of statements of opinion or argumentative matter and serves only to identify and authenticate the accompanying exhibits which constituted

the evidence hereinbefore designated. (See F. R. C. P. 56
re: evidence introduced by affidavits.)

Nowhere has Appellant challenged the right of the Court below or this Court to consider all of said evidence for all purposes, nor has Appellant attempted in any way to controvert the affidavit by which it was introduced.

B. The Evidence Upon Which the Decision in This Case Is Predicated Is Easily Understood—Extrinsic Evidence Is Not Required to Explain or Evaluate the Prior Art and Its Applicability to the Subject Matter of the Patent in Suit.

The conclusion stated in this topic heading will be obvious to this Court of Appeals from a mere inspection of the documentary evidence in the record. While Appellant challenges this statement, it is significant that Appellant does not anywhere designate or point out with any degree of particularity what parts of the evidence are so abstruse as to require extrinsic evidence for their explanation.

The truth of the matter is that the patent in suit, the prior art patents, and the file wrapper and contents of the patent in suit, are ordinary English language documents which are not technical in nature or subject matter and which relate to an extremely simple and well known process and an equally simple apparatus for carrying out the steps of that simple process. In such cases, Summary Judgment is proper [see cases cited by Trial Court at R. 137].

C. Absurd Contentions Concerning Inferences to Be Drawn From the Evidence Do Not Create Issues of Fact Which Are Either Genuine or Material.

Appellant seeks to raise a critical and controlling issue of fact by a lengthy, abstruse and almost incomprehensible discourse upon the alleged differences between a weir and

a screen. Such an argument tends to obscure the real issue—the question is whether the prior art teaches the essential method step claimed, and that method step is removing the solid parts of the removed sealant from the solvent before the solvent is pumped back to the spray heads. Since the patent is a method patent and deals with procedural steps, it matters not whether removal of such solid material is effected by a weir or a screen. Insofar as the patent in suit and the prior art are concerned, a weir and a screen are equivalents—they constitute substantially the same instrumentalities operating in substantially the same way to accomplish substantially the same result, *i.e.*, straining out the chunks of material dislodged by the sprays (*Celite Corp. v. Decalite Co.*, 96 F. 2d 242, 248).

Appellant also seeks to draw distinctions among “soap,” “soapy,” “emulsifier” and “a water-rinsable, solvent-miscible, emulsifying material.” The Court of Appeals will have no difficulty in ascertaining that whether one uses such simple and homely words as “soap” or “soapy” or seeks to hide behind abstruse language such as above quoted, the meaning is the same. All the patent calls for is something that has long been used in this particular art, *i. e.*, an emulsifying material which permits a water spray readily to rinse away loosened and emulsifiable materials adhering to the walls of the tank.

Appellant would have the Court believe that there is some great, vast and mysterious difference between aircraft fuel tanks and other kinds of tanks. This is predicated primarily upon the romance and glamor that is ordinarily associated with the flying of aircraft, particularly military aircraft, and the impressively large amounts of money that are involved in the military air operations. However, as soon as we get the stardust out of our eyes,

we can see that washing the inside of a tank by means of a spray is about the same sort of thing whether it is done inside an airplane wing tank or inside a railway tank car.

D. There Is No Issue of Fact, Genuine or Otherwise, as to the Contents of the Patent in Suit, the Contents of the File Wrapper Record, or the Contents of Various Prior Art Patents.

The Court of Appeals will at this point notice that Appellant has no quarrel actually with the evidence that was before the Court below and brought before this Court on this appeal; what Appellant quarrels with are the inferences which necessarily follow from that evidence. This Court will also realize that Appellant cannot conjure up a genuine issue of material fact by quarreling with the inference or the conclusion of law.

As this Court said in *Bergman v. Aluminum Lock Shingle Corp. of America*, 116 U. S. P. Q. 32:

“The nature of the prior art and the nature of what the patentee did to improve upon it must always be questions of fact. The question of the name to be given to what was done by the patentee, whether it is to be called an invention over the prior art or whether it is not, [is] a question fundamentally of the meaning of the words used in the statute, and as such would seem to be a question of law.”

E. No Weight or Consideration Should Be Given to Appellant’s Arguments on Matters Not Material to the Questions Raised by This Appeal.

Appellant cites more than thirty alleged errors; only about a dozen of these relate directly to the Findings of Fact accompanying the Judgment in this cause. Yet none of these challenged findings has been directly attacked by Appellant in its brief. Instead, Appellant seeks to cast

doubt upon a legal conclusion which necessarily follows from the undisputed facts, and on that basis urges that there is a disputed question of fact.

The truth of the matter is that there are no facts in dispute, and the Court of Appeals may readily ascertain that the Court below drew the correct inferences and arrived at the correct conclusions merely by placing the patent in suit and the prior art patents side by side.

F. Where the Entire Case Is Disposed of by a Decision on One Ground Which Is by Its Nature Dispositive of the Case, Factual Issues Involved in Other Grounds Are Not Material.

The court below found the patent in suit to be invalid for want of invention because of anticipation by the prior art. There can surely be no quarrel with the holding that a patent is invalid if it lacks invention and if it is anticipated by the prior art. This disposes of the case in its entirety and it is immaterial that Appellee urged to the Court below other reasons for granting the Judgment sought.

As this Court will have noted from the record, Appellee presented to the Court below evidence relating to other prior publications, as well as evidence relating to prior invention by another and prior public use. The lower Court, finding the patent to be invalid over the patented prior art, quite properly held that all other issues of fact became as a matter of law immaterial [R. 144-145 and cases there cited]. It would be a futile act to consider such other issues because, regardless of how such issues might be

decided, the ultimate judgment would remain unchanged—the patent in suit is invalid because it does not involve invention over the prior art as represented by the unchallenged and uncontroverted prior patents which were presented to the Court below and are by this appeal presented to this Court of Appeals.

G. Opinion Evidence by Expert Witness Which Is Not Needed to Explain the Patent or the Prior Art Must Be Taken for What It Is—Argument of Counsel.

Advocacy on the record through the affidavit of a patent lawyer employed by Appellant as an expert witness cannot create an issue of fact where none exists. Alleged “expert opinion” where none is needed, and amounting to no more than an argument of the case, cannot change the facts and must be ignored. A few quotations from the affidavit of William Douglas Sellers [R. 98-111] (upon which Appellant relies heavily to demonstrate the postulated existence of an issue of fact) will be sufficient to illustrate the point:

“No second and different spray to wash out an initial spray material is even remotely hinted at in Butterworth.”

“In short, Butterworth falls far short of showing the different elements of Claim 3 of the patent in suit, as stated.”

“As a matter of fact the draftsman simply was not careful and he forgot to leave the top of the pipe 5 open.”

“Butterworth is directed to removing a residual oil film and not to the problem of separating from a tank

a sealant that is essentially an integral part of the tank in normal operation, and without which sealant the tank is inoperative for fuel storage."

"Turning an airplane upsidedown is rather impractical, and in any event, aircraft sealant could not be removed without any spray, merely by a reverse flow."

"An expert in the field of aircraft fuel tanks could not be expected to know about coking chambers."

"This is a far cry from a method of rebuilding the sealed fuel tanks of aircraft by removing an integral lining, a task previously so difficult that men actually climbed inside and did the work by hand."

It is clear from the foregoing that there is here no genuine issue of material fact necessary to deciding the question of law involved, *i. e.*, validity of the patent in suit. (*Bergman v. Aluminum Lock Shingle Corp. of America*, 116 U. S. P. Q. 32.)

Despite Appellant's best efforts to the contrary, it is abundantly clear that with respect to each and every contention made by Appellant, there is no issue, or the facts involved are not material, or the alleged issue is not "genuine."

Appellant's contention that the judgment should be reversed because a trial is needed to ascertain the essential facts is clearly erroneous. The Judgment should be affirmed.

III.

THE PATENT IN SUIT IS INVALID AND THE JUDGMENT SO HOLDING SHOULD BE AFFIRMED.

As is pointed out above, the patent in suit is invalid for anticipation and want of invention. As the trial Court said:

“Here, it appears as a matter of law from undisputed facts disclosed by the letters and the file wrapper of patent 2,653,116, and the prior-art patents, both cited and non-cited, that the patent in suit is invalid because of ‘strict anticipation’ [35 U. S. C. §102(b)] or, in any event, for want of patentable novelty. [Id. §103.]” [R. 144.]

The judgment below [R. 153] so holding the patent in suit invalid is obviously correct and should be affirmed.

The granting of a Motion for Summary Judgment in this case was proper for the reasons hereinbefore explained. As the Trial Court said (paraphrasing the language of *Market Street Cable Railway v. Rowley*, 155 U. S. at 625):

“If, upon the state of the art as shown to exist by the prior patents, and upon a comparison of the older processes with the method described in the patent in suit, it should appear that the patent claims are not novel, or that the claimed invention is anticipated by the prior art, it becomes the duty of the court to grant summary judgment upon the issue of validity” [R. 143].

The Trial Court correctly held that there was no issue of fact, genuine or otherwise, as to the contents of the patent in suit, the contents of the file wrapper record of the Pat-

ent Office proceedings leading to the issuance of the patent in suit or the contents of the various prior art patents [R. 130, 146]. The Trial Court also correctly found that there could be no issue of fact, genuine or otherwise, that the enumerated patents (those not cited by the Examiner, but relied on by Appellee) were not cited or considered by the Patent Office in connection with the application for the patent in suit [R. 136]. The Trial Court also correctly found that in the fuel tank cleaning art and analogous arts, the essential steps of the method or process are easily understood from a reading of the claims of the patent in conjunction with the specification and drawings [R. 136]. The Trial Court also found correctly that extrinsic evidence is not needed to explain or evaluate the prior art and its applicability to the subject matter of the patent in suit [R. 151].

In this case, as this Court clearly explains in *Bergman v. Aluminum Lock Shingle Corp. of America*, 116 U. S. P. Q. 32, the question of validity is a question of law and the Court below correctly and properly decided that issue in granting Summary Judgment (F. R. C. P. 56).

It is suggested that Appellant is not entitled to any sympathy on its alleged loss of an opportunity to try this patent case to a jury. Appellant would have this Court believe that it had been "short circuited" out of a jury trial to which it was entitled as a matter of right. This is simply not so. In this case the Summary Judgment procedure has served its intended purpose; *i. e.*, that of disposing of litigation summarily and avoiding the cost and

burden of a full-fledged trial where the case boils down to a pure question of law without any genuine issues of material fact.

The fact of the matter is that the Trial Court placed the patent in suit and the prior art side by side and saw immediately and clearly that the patent was invalid—this Court of Appeals can, and should do the same thing.

For the reasons stated it is respectfully submitted that the judgment below should be affirmed.

Respectfully submitted,

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